

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

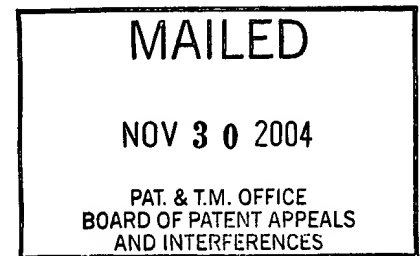
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROSHI MURAKAMI, YUKIO HONDA, SHIZUKA YOKOTE,
YOSHINARI ASANO, YUKITOSHI WADA, HIDEO HIROSE
and YASUAKI MATSUSHITA

Appeal No. 2005-0078
Application No. 09/520,149

ON BRIEF



Before FRANKFORT, STAAB, and DIXON, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner under 37 CFR § 41.50(a)(1) for appropriate action with regard to the items indicated below.

On January 16, 2003 appellants filed a reply brief containing arguments directed to the prior art rejections maintained by the examiner on appeal and addressing certain

positions of the examiner set forth in the answer. More particularly, appellants contend in their brief and reply brief that the references to Takahashi, Asai and Reiter relied upon by the examiner are directed to motors having stators with distributed windings rather than to a permanent magnet synchronous motor having a stator with "concentrated windings" as recited in the claims on appeal and, because of this, absent hindsight reliance on appellants' own disclosure, the applied references provide no teaching, suggestion or motivation for one of ordinary skill in the art to even attempt modification of the concentrated winding motor of the AAPA (Fig. 17) so as to obtain appellants' invention, since the motors of Takahashi, Asai and Reiter do not encounter the same problems addressed and overcome by the present invention. The reply brief also expressly disputes the examiner's position in the answer concerning what one of ordinary skill in the art would have derived from the above-noted references concerning the type of windings present therein and the examiner's findings concerning the relationships between air gap (Lg), clearance (La) and tooth depth (Lb) in the applied references vis-a-vis the particular relationships involving those same features set forth in the claims on appeal. On page 4 of the reply brief, appellants further contend that the

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examiner has no basis for his conclusion in the answer (page 4) that the depth (Lb) of each side edge of each tooth is a "result-effective variable," and that the examiner therefore has no basis for relying on In re Aller, 105 USPQ 233 (CCPA 1955) to say that the general conditions of the claims on appeal are disclosed in the prior art and that it is not inventive to discover the optimum or workable ranges of this variable by routine experimentation.

In response to the reply brief, the examiner sent out a notification (mailed April 9, 2003) informing appellants that the reply brief had been "entered and considered" and that the application was being forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Our problem at this point is that the examiner's *pro forma* response is woefully inadequate in this case to provide us with his views concerning the various arguments presented by appellants in the reply brief. Thus, we REMAND the application to the examiner for a response on the record to the arguments and issues raised by appellants in their reply brief. More particularly, since a full review of Takahashi, Asai and Reiter

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appears to evidence that those references are in fact directed to motors having stators with distributed windings, as urged by appellants, rather than to a permanent magnet synchronous motor having a stator with "concentrated windings" as recited in the claims on appeal, we seek from the examiner some explanation as to why or how the applied secondary references would have provided a teaching, suggestion or motivation to one of ordinary skill in the art at the time of appellants' invention to modify the concentrated winding motor of the AAPA (Fig. 17) so as to result in the motor claimed by appellants. The examiner must also specifically address appellants' argument concerning the lack of a teaching or recognition in the applied references that the depth (Lb) of each side edge of each tooth is a "result-effective variable."

As a further issue on remand, we solicit the examiner's views on why one of ordinary skill in the art at the time of appellants' invention would have used the broad disclosures in MacFarlane concerning a "dynamo electric machine" (circa 1930) in the particular type of permanent magnet synchronous motor having a stator with "concentrated windings" as disclosed in the AAPA


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(Fig. 17), and how any such modifications would have resulted in that which is specifically claimed by appellants.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (item D), Eighth Edition, Rev. 2, May 2004.

REMAND TO THE EXAMINER


CHARLES E. FRANKFORT)
Administrative Patent Judge)


LAWRENCE J. STAAB)
Administrative Patent Judge)


JOSEPH L. DIXON)
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS
) AND
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CEF/lbg

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